



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,405	07/29/2003	Hitoshi Saito	03500.017438.	6213

5514 7590 12/15/2005

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

WOO, STELLA L

ART UNIT PAPER NUMBER

2643

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,405

Applicant(s)

SAITO ET AL.

Examiner

Stella L. Woo

Art Unit

2643

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-27 is/are allowed.
- 6) ☒ Claim(s) 1-4, 8 and 12-14 is/are rejected.
- 7) ☒ Claim(s) 5-7, 9-11, 15 and 16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09/02/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 8, 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Moriizumi (US 5,187,736).

Regarding claims 1-4, 12, Moriizumi discloses a communication apparatus (Figure 3) comprising:

a first communication means (facsimile machine 1 with modem 16);
connecting means for connecting a second communication means
(telephone 4 is connected to telephone lines L1, L2 via facsimile machine 1);
first switch means (relay 21);
first route means (via contacts 22c);
second route means (via contacts 22b);
second switch means (switch 22);

first hook detector means (off-hook detector 24);
second hook detecting means (off-hook detector 23 connected between telephone line L1, L2 and second switch means 22).

Regarding claim 8, see Figure 5A, step S3.

3. Claims 13-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. (US 6,408,057 B1, hereinafter "Lee").

Regarding claim 13, Lee discloses a communication apparatus (Figure 3) capable of dialing from said communication apparatus in a state where a telephone set is connected and a handset is off-hooked (handset 180 is taken off-hook during dialing; col. 6, line 39 – col. 7, line 25; col. 8, lines 25-45) comprising:

line disconnecting means for disconnecting the handset from a line during dialing (via switch 350);

hook state detecting means for detecting a hook state of the handset from a line current (LIU 108 is powered by line current supplied from the telephone exchange system; col. 6, lines 39-41) in an inter-digit time of dialing (during dialing, CPU periodically transmits a "hook-status advice" command; col. 9, lines 21-30).

Regarding claim 14, if the handset 180 has been placed on-hook, the CPU_{FAX} 101 is informed and the operational mode is switched (col. 9, lines 36-66).

Allowable Subject Matter

4. Claims 5-7, 9-11, 15-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. Claims 17-27 are allowed.

Lee shows a communication apparatus in which a hook status detecting means is powered by the telephone line. However, Lee does not teach or fairly suggest a second switch means, as recited in independent claims 17, 18, 19, 26.

Ohnishi shows a communication apparatus with a first switch means (36), a second switch means (43), a first hook detecting means (41). Ohnishi does not teach or fairly suggest a hook detecting means which detects a hook state of the telephone set from a current supplied from the telephone line, as recited in independent claims 17, 18, 19, 26. Rather, in Ohnishi, the hook status detecting circuit uses a current provided by DC voltage generating circuit 42 (col. 4, lines 33-43).

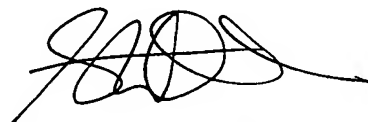
Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kaufeld et al. show the handling of interruptions during dialing.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number

is (571) 272-7512. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Stella L. Woo', with a stylized flourish extending to the right.

Stella L. Woo
Primary Examiner
Art Unit 2643